

### **REMARKS/ARGUMENTS**

Responsive to the Final Office Action mailed November 9, 2006, Claims 1-23 remain pending for prosecution with Claims 1 and 12 being independent.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claim combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. In re Vaeck, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

#### **I. Rejection of Claims 1-4 and 8-13**

Claims 1-4 and 8-13 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Kirkhuff does not teach or suggest the claimed invention. In particular, Kirkhuff fails to teach or suggest the following elements of Applicant's claimed invention: (1) a composite starter block *having a unitary construction*; and (2) tapered side surfaces.

Rather than a composite starter block *having a unitary construction*, Kirkhuff teaches a separate starter strip 70 and a separate body member 72 having a separate top plate 74 and a separate bottom plate 76. These separate components are then assembled together to form Kirkhuff's eaves starter strip. The Office Action does not even address this feature of

Applicant's claimed invention nor does the Office Action provide any make any claim whatsoever that Kirkhuff does teach this element of Applicant's invention. Moreover, the Office Action utterly fails to respond to Applicant's previously-submitted arguments that Kirkhuff does not teach or suggest a composite starter block of unitary construction but rather teaches a multi-component starter strip. The secondary reference to Gleason also fails to teach or suggest a composite starter block having unitary construction. In fact, Gleason does not teach or suggest starter blocks at all. Rather, Gleason only briefly mentions that “[p]reliminary to applying panels to a roof, a metal starter strip (not shown) is nailed to the roof and extends closely adjacent and parallel to the eave.” Column 3, lines 54-56. Thus, Kirkhuff and Gleason, individually and in combination, fail to teach or suggest Applicant's composite starter block having a unitary construction.

Moreover, it is admitted in the Office Action that Kirkhuff fails to teach or suggest tapered side edges. However, it is asserted that “tapered side edges is [sic] known in the art of shingles as shown by Gleason et al., element 14, figure 3.” Applicant respectfully submits that this combination is inapposite. First, there is no teaching or suggestion in Gleason to provide a starter block at all. Gleason only teaches shingles. The sole teaching by Gleason is for a metal starter strip as discussed above. In response to Applicant's previously-submitted arguments in this vein, the Office Action states that “[r]eason [sic] expectation of success has been shown such as ease of installation. The prior art suggest [sic] the claimed limitation or the limitations are within [sic] the scope of the inventions of the prior art. The prior art teaches the claimed limitations thus the same may be termed a starter block. The secondary references are not bodily incorporated into the teaching of the base references but are cited to show some favorable feature

known in the building or roof industry.” Applicant respectfully traverses this mischaracterization of what constitutes a prima facie case of obviousness.

First, the Office Action has failed to demonstrate the suggestion or motivation, present either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings as required by the first criteria of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office Action appears to be asserting that, because the Gleason reference allegedly contains tapered side edges, “the prior art teaches the claimed limitations thus the same may be termed a starter block.” First, Applicant respectfully submits that just because the shingles taught by Gleason allegedly possess tapered side edges that does not mean that the shingles somehow become starter blocks. There is absolutely no suggestion or motivation in Kirkhuff or Gleason to combine a feature of Gleason’s shingles with Kirkhuff’s starter strip. In fact, this combination would render Kirkhuff’s starter strip unsatisfactory for its intended purpose. Kirkhuff discloses a dependent starter system. That is, Kirkhuff requires a specific starter/shingle alignment due to the interlocking nature of the starter strip and shingle. As a result, Kirkhuff’s starter strip cannot be used with any shingle system but can only be used with Kirkhuff’s shingle. Adding tapered edges to Kirkhuff’s starter strip would destroy the interlocking nature of the starter strip and shingle and would render it inoperable for use with Kirkhuff’s shingles. Since the proposed modification of Kirkhuff would render Kirkhuff’s starter strip unsatisfactory, no suggestion or motivation to make the proposed modification exists. In re Gordon, 221 USPQ 1125 (Fed. Cir. 1984).

Moreover, Applicant respectfully submits that Gleason does not, in fact, teach tapered side edges at all. Element 14 in figure 3 does not designate a tapered side edge of the shingle, but rather designates the lower edge 14 of roofing panel 10. Finally, with respect to Claim 2, neither Kirkhuff nor Gleason teaches a starter block wherein the width of the starter block is substantially equal to the width of the shingle. Rather, Kirkhuff teaches that the eaves starter strip may be provided with channels in the forward face thereof to simulate division between shingles when it is fabricated in lateral lengths exceeding the length of a single shingle. Gleason teaches only a metal starter strip and does not teach that this starter strip has a width that is substantially equal to the width of the shingle. Thus, Kirkhuff and Gleason, individually and in combination, fail to teach or suggest Applicant's starter block having tapered side edges and also fail to teach or suggest a starter block wherein the width of the starter block is substantially equal to the width of the shingle.

Moreover, the Kirkhuff starter strip functions as a filler piece and does not provide any aid in laying of the shingles as taught by Applicant. In addition, Kirkhuff's starter strip mirrors the trailing edge of a normal shingle strip for interlocking purposes. Thus, the starter strip is dimensionally the same size as the shingle strip whereas, in the present invention, the starter is a separate entity that functions independently of the shingle course and can be used with varying shingle widths.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in either Kirkhuff or Gleason to provide a composite starter block having unitary construction, tapered side edges, and a width substantially equal to the width of the shingle. Moreover, there is no expectation of

success in the combination of Kirkhuff and Gleason since neither discloses these elements of Applicant's claimed invention and the proposed modification of Kirkhuff would render Kirkhuff's starter strip unsatisfactory for its intended purpose. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, neither Kirkhuff nor Gleason teach or suggest all of the elements of Applicant's independent Claims 1 and 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, both Kirkhuff and Gleason fail to teach or describe all of the limitations claimed by Applicant in independent Claims 1 and 12 and the claims depending therefrom. Accordingly, Claims 1-4 and 8-13 are therefore nonobvious under § 103(a).

## **II. Rejection of Claim 5**

Claim 5 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al. as applied to Claim 1 and further in view of U.S. Patent No. 5,953,862 to Earhardt. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Earhardt also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Earhardt merely teaches a plastic shim for use in building. The asserted "nailing zone" taught by Earhardt serves a different purpose than that of the claimed invention. Earhardt's nailing divot is not for ensuring proper nail placement but rather for weakening the fastening strength of the nail by causing the shim to split in the indented area.

Furthermore, Earhardt is not analogous art. In order to rely on a reference as a basis for rejection of an applicant's invention, the reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the invention was concerned. In re Oetiker, 24 USPQ2d 1443 (Fed. Cir. 1992). Applicant's field of endeavor relates to roofing and, in particular, a starter block for roofing shingles. The Earhardt reference, on the other hand, is directed to shims which are used to fill gaps, level items such as doors, windows or cabinets, or to adjust such items to fit properly. This reference deals with completely different subject matter and would not logically have commended itself to the inventor's attention in considering the problem at hand in the present invention.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, or Earhardt to provide a composite starter block having unitary construction and tapered side edges. One skilled in the art would also not look to Earhardt for motivation because it is nonanalogous art. Moreover, there is no expectation of success in the combination of Kirkhuff, Gleason, and Earhardt since none of these references disclose a composite starter block having unitary construction and tapered side edges. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, and Earhardt all fail to teach or suggest all of the elements of Applicant's independent Claim 1. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, and Earhardt alone or in combination, all fail to teach or describe all of the limitations claimed by Applicant in

independent Claim 1 and its dependent Claim 5. Accordingly, Claim 5 is therefore nonobvious under § 103(a).

### **III. Rejection of Claims 6 and 7**

Claims 6 and 7 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff in view of U.S. Patent No. 4,279,106 to Gleason et al. as applied to Claim 1 and further in view of U.S. Patent No. 2,142,996 to Bussey. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Bussey also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Bussey merely teaches metallic shingles that are symmetrical, reversible and interlockable. Contrary to the Office Action's assertions, the "nib" taught by Bussey is not a spacer. Rather, it is an integral part of Bussey's interlocking system. In the present invention, the claimed nib or spacer tab ensures consistent spacing.

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, or Bussey to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in the combination of Kirkhuff, Gleason, and Bussey since none of these references disclose these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, and Bussey all fail to teach or suggest all of the elements of

Applicant's independent Claim 1. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 1 and its dependent Claims 6 and 7. Accordingly, Claims 6 and 7 are therefore nonobvious under § 103(a).

#### **IV. Rejection of Claims 12-15 and 19-23**

Claims 12-15 and 19-23 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 to Hardy in view of U.S. Patent No. 3,852,934 to Kirkhuff and U.S. Patent No. 4,279,106 to Gleason et al. and further in view of U.S. Patent No. 6,199,338 to Hudson, Jr.. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Hardy does not teach or suggest the claimed invention. In particular, Hardy fails to teach or suggest the following elements of Applicant's claimed invention: (1) a course of composite starter blocks *having a unitary construction*; and (2) tapered side surfaces.

Hardy fails to teach or suggest the claimed invention. In particular, Hardy fails to teach or suggest a course of composite starter blocks having a unitary construction and tapered side edges. Rather, Hardy teaches that “[f]or the starting strip, a board 50 may be secured to the underside of the sheathing 10, this board extending beyond the edge of the sheathing and built up as by members 52, 52, the latter conforming in thickness to the thickness of the butt edge of the shingle.” Moreover, it is admitted in the Office Action that Hardy fails to teach or suggest tapered side edges. However, it is asserted that “tapered side edges is [sic] known in the shingles [sic] as shown by Gleason et al., element 14, figure 3.” Applicant respectfully submits that this

combination is inapposite. First, there is no teaching or suggestion in Gleason to provide a starter block at all. Gleason only teaches shingles. The sole teaching by Gleason is for a metal starter strip as discussed above. In response to Applicant's previously-submitted arguments in this vein, the Office Action states that “[r]eason [sic] expectation of success has been shown such as ease of installation. The prior art suggest [sic] the claimed limitation or the limitations are within [sic] the scope of the inventions of the prior art. The prior art teaches the claimed limitations thus the same may be termed a starter block. The secondary references are not bodily incorporated into the teaching of the base references but are cited to show some favorable feature known in the building or roof industry.” Applicant respectfully traverses this mischaracterization of what constitutes a *prima facie* case of obviousness.

First, the Office Action has failed to demonstrate the suggestion or motivation, present either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to combine the reference teachings as required by the first criteria of obviousness. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. In re Mills, 16 USPQ2d 1430 (Fed. Cir. 1990). The Office Action appears to be asserting that, because the Gleason reference allegedly contains tapered side edges, “the prior art teaches the claimed limitations thus the same may be termed a starter block.” First, Applicant respectfully submits that just because the shingles taught by Gleason allegedly possess tapered side edges that does not mean that the shingles somehow become starter blocks. There is absolutely no suggestion or motivation in Hardy or Gleason to combine a feature of Gleason’s shingles with Hardy’s starter strip. Moreover, Applicant respectfully submits that Gleason does not, in fact,

teach tapered side edges at all. Element 14 in figure 3 does not designate a tapered side edge of the shingle, but rather designates the lower edge 14 of roofing panel 10.

As discussed above, neither Kirkhuff nor Gleason teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Hudson also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Hudson is asserted to merely teach “a course of starter shingles of the same length as the shingles.”

Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, or Hudson to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in the combination of Hardy, Kirkhuff, Gleason, or Hudson since none of these references disclose these elements of Applicant’s claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or suggest all of the elements of Applicant’s independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Hardy, Kirkhuff, Gleason, and Hudson, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 12 and the claims depending therefrom. Accordingly, Claims 12-15 and 19-23 are therefore nonobvious under § 103(a).

## V. Rejection of Claim 16

Claim 16 was rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 2,193,233 to Hardy in view of U.S. Patent No. 3,852,934 to Kirkhuff and U.S. Patent No. 4,279,106 to Gleason et al. and U.S. Patent No. 6,199,338 to Hudson, Jr. as applied to Claim 12 and further in view of U.S. Patent No. 5,953,862 to Earhardt. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, Hardy, Kirkhuff, Gleason, and Hudson all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges. Similarly, Earhardt also fails to teach or suggest a composite starter block having a unitary construction and tapered side edges. Rather, Earhardt is asserted to merely teach that “the nailing zone is not indented.” Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Hardy, Kirkhuff, Gleason, Hudson, or Earhardt to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Hardy, Kirkhuff, Gleason, Hudson, or Earhardt since none of these references disclose these elements of Applicant’s claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Hardy, Kirkhuff, Gleason, Hudson, and Earhardt, all fail to teach or suggest all of the elements of Applicant’s independent Claim 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Hardy, Kirkhuff, Gleason, Hudson, and Earhardt, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claim 12 and the claims depending therefrom. Accordingly, Claim 16 is therefore nonobvious under § 103(a).

## VI. Rejection of Claims 17-18

Claims 17-18 were rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,852,934 to Kirkhuff, U.S. Patent No. 4,279,106 to Gleason et al. and U.S. Patent No. 6,199,338 to Hudson, Jr. as applied to Claim 12 and further in view of U.S. Patent No. 2,142,996 to Bussey. For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

As discussed above, Kirkhuff, Gleason, Hudson, and Bussey all fail to teach or suggest a composite starter block having a unitary construction and tapered side edges. Prima facie obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. No such suggestion or motivation exists in Kirkhuff, Gleason, Hudson, or Bussey to provide a composite starter block having unitary construction and tapered side edges. Moreover, there is no expectation of success in that the combination of Kirkhuff, Gleason, Hudson, or Bussey since none of these references disclose these elements of Applicant's claimed invention. Finally, the prior art references must teach or suggest all the claim limitations. As discussed above, Kirkhuff, Gleason, Hudson, and Bussey, all fail to teach or suggest all of the elements of Applicant's independent Claims 1 and 12. Unless all the elements are taught by the references, there can be no success in modifying them.

Thus, at the time the present invention was made, Kirkhuff, Gleason, Hudson, and Bussey, alone or in combination, fail to teach or describe all of the limitations claimed by Applicant in independent Claims 1 and 12 and the claims depending therefrom. Accordingly, Claims 17-18 are therefore nonobvious under § 103(a).

## VII. Conclusion

Applicant respectfully submits the claims are in condition for formal allowance which is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No. 11-0160.

Respectfully submitted,

Date: 02.09.2007

  
\_\_\_\_\_  
Lara Dickey Lewis  
Reg. No. 48,161  
Blackwell Sanders Peper Martin LLP  
4801 Main St., Suite 1000  
Kansas City, MO 64112  
816-983-8000  
ATTORNEYS FOR APPLICANT